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In re Application of :
MACNALLY et al. :
U.S. Application No. 09/762,720 :
PCT No.: PCT/US99/20792 : DECISION ON PETITION
Int. Filing Date: 10 September 1999 : UNDER 37 CFR 1.47(a)
Priority Date: 10 September 1998 :
Attorney Docket No.: 30019.70USWO :
For: A SINGLE-CHIP CMOS DIRECT :
CONVERSION TRANSCEIVER :

This is a decision on applicants' "PETITION UNDER 37 CFR 1.47(a)" filed 19 June 2001 to accept the application without the signature of joint inventors, Donald Evan MacNally and Laurence Marguerite Plouvier. The required petition fee of \$130.00 (37 CFR 1.17(i)) has been submitted.

BACKGROUND

On 10 September 1999, applicants filed international application PCT/US99/20792 which claimed a priority date of 10 September 1998 and which designated the United States. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 10 June 2001.

On 08 February 2001, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); preliminary amendment; and an unexecuted declaration.

On 19 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b).

On 19 June 2001, applicants filed: "Communication Regarding Missing Requirements"; a declarations and power of attorneys signed by seven of the nine joint inventors; a petition under 37 CFR 1.47(a) and the requisite fee; and a two-month extension and the requisite fee.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4).

As to item (2), petitioner states that Donald Evan MacNally and Laurence Marguerite Plouvier cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the present petition and the accompanying papers reveal that applicant has not satisfied item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Donald Evan MacNally and Laurence Marguerite Plouvier. Ms. Xu states in her letters (Exhibit A1 and A2) to Donald Evan MacNally and Laurence Marguerite Plouvier, "we must now provide the formal papers (a Combined Declaration and Power of Attorney and Assignment). . ." The mailing of the Declaration and Power of Attorney and Assignment is not considered a complete copy of the application paper (specification, including claims,

drawings, and oath and declaration).

Additionally, petitioner states that Donald Evan MacNally and Laurence Marguerite Plouvier cannot be found or reached after diligent effort. A review of the present petition reveal that applicants have not provided an acceptable showing that a diligent effort was made to reach the non-signing inventors, Donald Evan MacNally and Laurence Marguerite Plouvier. Moreover, a review of FedEx website tracking database reveals that Donald McNally signed for both set of papers on 13 April 2001 and therefore, petitioner cannot assert that Donald Evan MacNally and Laurence Marguerite Plouvier cannot be found or located.

For the reasons stated above, it would not be appropriate to accept the application without the signatures of Donald Evan MacNally and Laurence Marguerite Plouvier under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.


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